

Application No.: 10/755,747
Response to Office Action of August 29, 2005
Attorney Docket: EQUUS-074Q

Amendment to the Drawings:

Applicant has amended the drawing to identify the interior side and the exterior side of the bracket. Applicant submits concurrently herewith Exhibit A which is a new Figure 4 identifying the interior side 37 and the exterior side 39. New Figure 4 additionally identifies a gauge lip 45 and a surface 41 about a periphery 43.

REMARKS

This is a response to the Office Action of August 29, 2005.

I. SUMMARY OF OFFICE ACTION

In the Office Action, the Examiner rejected the finality of the previous office action.

The Examiner objected to the drawings under 37 C.F.R. 1.83(a).

The Examiner also objected to the specification as failing to provide proper antecedent basis for the claimed subject matter in Claims 11 and 13.

The Examiner rejected Claim 13 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

Claims 1, 5 and 7-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,507,706 issued to Trexler, Jr. in view of U.S. Patent No. 5,702,076 issued to Humber. Claims 3 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Trexler, Jr. combined with Humber and in further view of Longo. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Trexler combined with Humber and in further view of U.S. Patent No. 3,603,551 issued to Peterson. Claims 1, 3 and 7-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's admitted prior art ("APA") in Figures 1 and 2 in view of U.S. Patent No. 3,365,761 issued to Kalvig.

The Examiner indicated that Applicant's arguments filed April 20, 2005 have been fully considered but they are not persuasive.

II. APPLICANT'S RESPONSE

A. Drawings

Applicant has amended the drawing to identify the interior side and the exterior side of the bracket. Applicant submits concurrently herewith Exhibit A which is a new Figure 4 identifying the interior side 37, the exterior side 39, a gauge lip 45, a surface 41 about a periphery 43. Applicant respectfully submits that the Examiner's objection to the drawings have been overcome by submission of new Figure 4.

B. Specification

The Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, specifically, an interior side, an exterior side and a lip as recited in Claims 11 and 13. By this Amendment, Applicant has inserted new paragraph [0028] which conforms the specification to the language of Claims 11 and 13. By this Amendment, Applicant respectfully submits that the Examiner's objection to the specification has been overcome.

C. Claims Rejections - 35 U.S.C. § 112

Claim 13 was rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement based on a view that neither the description nor drawings clearly show a lip of the gauge being received by a surface of the bracket about the periphery of the aperture. The Examiner further stated that "the drawings do show that the lip/bezel of the gauge comes in contact with a surface about the periphery of the aperture." (Office Action, p. 4) In response, Applicant has amended Claim 13 to track the language of the Examiner. In particular, Applicant replaces the terms "is received by" with "contacts." Accordingly, Applicant respectfully submits that the Examiner's rejection of Claim 13 under 35 U.S.C. § 112, first paragraph has been overcome.

D. Claim Rejections - 35 U.S.C. § 103

Claim 1 was rejected under 35 U.S.C. § 103 as being unpatentable over Trexler, Jr. in view of Humber based on a view that "it would have been obvious to one having ordinary skill in the art to have included the insulator as taught by Humber for the purpose of providing a means holding a cylindrical object such as a gauge rigidly in position and to accommodate different sized objects." (Office Action, p. 5). In response, Applicant directs the Examiner's attention to *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) which supports the proposition that the teaching, motivation, or suggestion to combine found in the prior art must be specific. The Kotzab Court stated that "particular findings must be made as to the reason that a skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." (emphasis added) *Id.*; *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the skill in the art is high, the Board must identify specifically

the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant).

Applicant respectfully submits that the Examiner has not provided specific evidence which shows any teaching, motivation, or suggestion to combine the Humber segments with the Trexler, Jr. device. A general statement that one of ordinary skill in the art would have combined the Humber segments into the Trexler device to provide a means holding cylindrical object does not appear to be sufficiently specific as required by the *Kotzab* Court. The Examiner has not provided any specific reasons that one of ordinary skill in the art would have selected the Humber segments over other types of means holding cylindrical objects.

The Examiner also stated that one of ordinary skill in the art would have been motivated to combine the Humber segments into the Trexler device such that different sized gauges could be accommodated in the Trexler device. However, this reason is also deficient based on a view that such reason does not show why one of ordinary skill in the art would have selected the Humber segments over other types of ways of accommodating different size gauges for combination with the Trexler device. It appears that the Examiner has used hindsight based obviousness analysis to conclude that the invention recited in Claim 1 is obvious as to Trexler in view of Humber. Hence, the invention recited in Claim 1 is non obvious over Trexler, Jr. in view of Humber.

Applicant also respectfully submits that there is no motivation to combine the Humber segments into the Trexler device based on secondary considerations. MPEP § 2141, pg. 2100-121 makes clear that “objective evidence or secondary evidence such as ... long felt need ... are relevant to the issue of obviousness and must be considered in every case in which they are presented.” In particular, there has been a long felt need for a device to enable a gauge to be assembled to a bracket without any mating nut or threaded ring as long as gauges have been incorporated into vehicles. However, the Examiner has failed to provide

a reference which incorporates a plurality of displaceable segments in a bracket with friction fit engagement to a gauge as recited in Claim 1 for retaining the gauge in the bracket. Instead, the Examiner cites to Humber which is directed to holding water pipes and has no relevance to gauges for the proposition that one of ordinary skill in the art would have combined the Humber segments into the Trexler device. Applicant respectfully submits that based on the long felt but unresolved need of assembling a gauge without a mating nut or threaded ring, there is no motivation to combine the Humber segments into the Trexler device.

Applicant maintains that there is no motivations to combine the segments of Humber with the device of Trexler, Jr. as discussed in the Applicant's response filed May 17, 2005. In particular, the device of Trexler, Jr. allows gauges to be interchangeably mounted (i.e., an intended purpose of the Trexler, Jr. device; col. 2, lns. 15-16), and incorporation of the segments of Humber would prevent the gauges from being interchangeably mounted to the device of Trexler, Jr. thereby making inoperable an intended purpose of the Trexler, Jr. device. (Response of May 17, 2005, pgs. 5-7).

In the current Office Action, the Examiner responded to Applicant's argument by stating that the segments in Humber are not intended to permanently retain the pipe within the aperture. The Examiner further stated that the segments of Humber are flexible and resilient thus making it easy for the pipe/gauge to be interchangeable. As understood, the Examiner concluded that since the segments in Humber are flexible and resilient, the pipe is interchangeable. However, Applicant respectfully submits that flexibility and resiliency does not equate to interchangeability.

In support thereof, Applicant directs the Examiner's attention to the specification of Trexler, Jr., specifically, the abstract which recites that the pipe (i.e., gauge) passes through the cylindrical body (i.e., bracket aperture) while holding the pipe rigidly in position. Additionally, Column 1, lines 51-53 recite that the insulator (i.e., segments) provides a firm mount for the pipe (i.e., gauge). Furthermore, column 2, lines 51-54 recite that the pipe (i.e., gauge) is held rigidly by the segments. Accordingly, by the language of the Trexler, Jr. disclosure, it appears that the gauge may not be removable from the bracket once the gauge is

held rigidly by the segments if the segments of Humber were incorporated into the Trexler, Jr. device.

Moreover, other parts of the Humber device may be characterized as being flexible and resilient but may not be characterized as being interchangeable. For example, the mounting fingers 16 of Humber may be characterized as flexible and resilient, as understood. However, the mounting finger may not be characterized as interchangeable. Column 3, lines 2-5 recite that the mounting fingers deflect (i.e., flexible) inwardly then spring back outwardly (i.e., resilient) in order to firmly hold the mounting flange against the metal stud. Accordingly, the mounting fingers 16 prevent the insulator from being pulled out from the metal stud once the mounting fingers firmly hold the mounting flange to the metal stud. Accordingly, even though the mounting fingers may be characterized as flexible and resilient, the mounting fingers may not be characterized as interchangeable. Likewise, even though the segments of Humber are flexible and resilient, the segments of Humber may not permit the pipe/gauge to be interchangeable. Accordingly, Applicant submits that there is no motivation to combine the Humber segments into the Trexler, Jr. device based on a view that to do so would make the Trexler, Jr. device inoperable for an intended purpose (i.e., interchangeability) of the Trexler, Jr. device. Hence, Applicant respectfully submits that the invention of Claim 1 is non obvious as to Trexler in view of Humber.

There is also no motivation to combine the segments of Humber into the device of Trexler, Jr. based on a view that to do so would make inoperable an intended use of Trexler, Jr. Column 3, lines 49-54 recites that alignment ribs 14 are received into slots 24 to insure that the gauge is properly aligned to apertures as well as terminals and brackets on the circuit board. However, Applicant respectfully submits that if the segments of Humber were incorporated into the device of Trexler, Jr., then the alignment rib would be incapable of being received into slots for alignment of the gauges. In support thereof, Applicant respectfully directs the Examiner's attention to Figure 6 of Humber which illustrates the pipe within the insulator. As shown, the pipe only contacts the distal ends of the segments. More importantly, a space exists between the aperture diameter and the pipe exterior surface thereby preventing engagement of the slot and the alignment rib if the Humber segments were incorporated into the Trexler, Jr. device. Accordingly, incorporation of the insulator of

Humber into the device of Trexler, Jr. may make the Trexler device inoperable for its intended use of aligning the gauge based on a view the space between the aperture diameter and the pipe/gauge exterior surface prevents the alignment rib from being received into the slot. Hence, Applicant respectfully submits that there is no motivation to combine the segments of Humber into the device of Trexler, Jr. As such, the invention recited in Claim 1 is non obvious as to Trexler in view of Humber.

There is no motivation to combine the segments taught in Humber into the device of Trexler based on a view that there is no reasonable expectation of success that the gauges will remain in the bracket if such combination is made. The device of Trexler is incorporated into vehicles. Vehicles are constantly vibrating such that vehicle components must be designed to stay together despite vibration. For example, split washers may be used on all bolt / nut combinations. As understood, the device of Trexler, Jr. resolves this vibration problem with the gauges via the mounting pin 18 and the bracket combination 48. Column 3, lines 62-65 recite that the mounting pin extends through aperture 38 and is held in place by aperture and bracket combination 48.

If the segments of Humber were incorporated into the device of Trexler, Jr., then there is no reasonable expectation of success that the gauge would remain on the bracket. As understood, the gauges would vibrate out of the apertures if only the segments of Humber were holding the gauges to the aperture. If the mounting pin 18 and the aperture/bracket combination 48 were also holding the gauges, then there is no motivation combine the Humber segments into the Trexler device because there is no need for the Humber segments. It appears that the disclosure of Humber is silent as to whether the segments of Humber are sufficient to hold the gauges in the aperture in the presence of vibration. The segments of Humber are directed to holding a water pipe. Such pipes are fixed at its distal ends to a wall or other stationary object. Accordingly, even though there may be vibration through "water hammer," the fixation of the distal ends to the stationary object prevents the pipe from moving from such vibration. The Humber disclosure did not have to resolve the issue of vibration and how the pipe would react to vibration in the instance that the pipe was not fixed to the stationary object at its distal ends. Accordingly, there appears to be no reasonable expectation that incorporating the segments of Humber into the Trexler, Jr. device would

permit the Trexler, Jr. device to firmly hold the gauge in the bracket despite vibration from the vehicle. Thus, the invention recited in Claim 1 is non obvious as to Trexler, Jr. in view of Humber.

With respect to the Examiner's rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over APA in view of Kalvig, Applicant respectfully submits that there is no motivation to combine the teachings of Kalvig into the APA discussed above in relation to vibration. The Kalvig disclosure is directed to holding broom handles, rods, shank or other similar stem-like elements. (Column 2, lines 51-52). The device of Kalvig does not apparently address vibration or what occurs to the stem-like object in the presence of vibration - whether the stem-like object would be retained within the bracket. It is unknown whether the Kalvig device is capable of retaining the stem-like element in the presence of vibration. Accordingly, there appears to be no reasonable expectation that incorporating the segments of Kalvig into the APA device would permit the gauge to be retained within the aperture based on a view that the vehicle's vibration may displace the gauge out of the aperture, as discussed above in relation to vibration. Accordingly, Applicant respectfully submits that the invention recited in Claim 1 is non obvious as to APA in view of Kalvig.

Applicant also respectfully submits that the Examiner has failed to provide evidence to show a teaching, motivation, or suggestion to combine the selected components of Kalvig into the APA. In the Office Action, the Examiner stated that the person of ordinary skill would have combined the teachings of Kalvig into the APA to provide an alternative mechanically equivalent means for retaining the gauge within the bracket. However, as understood, the Examiner has not provided specific reasons that one of ordinary skill would have chosen to incorporate the Kalvig means for retaining over other means for retaining. Just because two references are combinable does not make the combination of the two references obvious.

The examiner also stated that the combination of APA in view of Kalvig is obvious based on a view that one of ordinary skill would have made such combination for the purpose of providing a means for easier installation of the gauge within the aperture of the bracket. However, it appears that it is unknown whether installation of the gauge via Kalvig is easier than an installation of the gauge via APA from the references cited by the Examiner. Such

conclusion must be based on evidence that is made of record. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). Hence, Applicant respectfully submits that the invention recited in Claim 1 is non obvious as to APA in view of Kalvig.

Applicant also respectfully submit that there is no motivation to combine the teachings of Kalvig into the APA for the same reasons discussed above in relation to long felt but unresolved need. In particular, there has been a long felt need for a device to enable a gauge to be assembled to a bracket without any mating nut or threaded ring as long as gauges have been incorporated into vehicles. However, the Examiner has failed to provide a reference which incorporates a plurality of displaceable segments in a bracket with friction fit engagement to a gauge for retaining the gauge in the bracket. Instead, the Examiner cites to Kalvig which is directed to holding brooms and the like and has no relevance to gauges for the proposition that one of ordinary skill in the art would have combined the teachings of Kalvig into the APA. Applicant respectfully submits that based on the long felt but unresolved need of assembling a gauge without a mating nut or threaded ring, there is no motivation to combine the teachings of Kalvig into the APA.

For the foregoing reasons, Applicant respectfully submit that Claim 1 is in condition for allowance.

E. DEPENDENT CLAIMS OF CLAIM 1

The dependent claims of Claim 1, namely Claims 3-13 are also believed to be in condition for allowance for being dependent upon allowable base Claim 1. Furthermore, Claims 3-13 are believed to be in condition for allowance for containing additional patentable subject matter. For example, Claim 13 recites that the gauge is insertable through the aperture from the exterior side to the interior side until the gauge lip contacts the surface about the aperture periphery. Applicant respectfully submits that the cited prior art does not disclose, suggest or make obvious such limitation. Hence, Claim 13 is believed to be in condition for allowance as well as Claims 3-12.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully submits that all of the stated grounds of rejection and objection have been overcome, and that Claims 1 and 3-13 are in condition for allowance. An early Notice of Allowance is therefore respectfully requested.

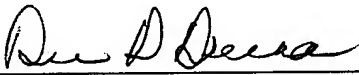
Should the Examiner have any suggestions for expediting allowance of the application, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

If any additional fee is required, please charge Deposit Account Number 19-4330.

Respectfully submitted,

Date: September 13, 2005

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